

## **REMARKS**

### **I. Introduction**

Claims 1, 3 to 7, 9, 10 and 24 to 26 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Objection to Claim 3**

As regards the objection to claim 3, the Examiner will note that claim 3 has been amended herein without prejudice to depend from claim 10 and has been amended herein without prejudice to recite that "the carbide of transitional elements, boride of transitional elements and lanthanides form one of mixed oxides, silicides, carbides and borides." It is therefore respectfully submitted that claim 3 fully complies with the requirements of 37 C.F.R. § 1.75(c), and withdrawal of this objection is respectfully requested.

### **III. Rejection of Claim 3 Under 35 U.S.C. § 112, 2<sup>nd</sup>**

As regards the rejection of claim 3 under 35 U.S.C. § 112, as indicated above claim 3 has been amended herein without prejudice to depend from claim 10 and has been amended herein without prejudice to recite that "the carbide of transitional elements, boride of transitional elements and lanthanides form one of mixed oxides, silicides, carbides and borides." It is therefore respectfully submitted that claim 3 fully complies with the requirements of 35 U.S.C. § 112, and withdrawal of this objection is respectfully requested.

### **IV. Provisional Double Patenting Rejection**

As regards the provisional double patenting rejection, Applicant takes no position with respect to this provisional rejection at this time and reserve its rights with respect to the present application and co-pending U.S. Patent Application Serial No. 10/917,428. Notwithstanding the foregoing, if warranted, Applicant is prepared to respond to this provisional double patenting rejection if and when made non-provisional.

**V. Rejection of Claims 1, 3 to 7 and 9 Under 35 U.S.C. § 102(e)**

Claims 1, 3 to 7 and 9 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,558,746 ("Starz et al."). Applicant respectfully submits that Starz et al. do not anticipate the present claims as amended herein for at least the following reasons.

Claim 1 relates to an initial solids coating mixture. Claim 1 has been amended herein without prejudice to recite that the initial solids mixture includes an aqueous or water containing organic adhesive agent and electrically conductive additive particles including boron carbide and zinc. Claim 1 has further been amended herein without prejudice to recite that an electrical conductivity of the boron carbide is in the metallic range. Claim 1 has further been amended herein without prejudice to recite that the proportion of adhesive agent to additive particles is in a range of 1:3. Claim 1 has further been amended herein without prejudice to recite that the aqueous or water containing organic adhesive agent includes hexamethylenetetramine. Support for these amendments may be found, for example, in original claims 1, 10, 25 and 26. Claim 1 further recites that the additive particles are configured to have a continuous physical connection in at least one spatial direction.

Claim 1 has been amended to include features from claims 10, 25 and 26, which were indicated to include allowable subject matter, including features that the Office Action admits is not disclosed by the cited references. The Office Action admits, for example, that a coating having at least one of the non-noble metals consisting of zinc or aluminum, a ratio of adhesives to additive particles of 1:2 and the adhesive including hexamethylenetetramine are not disclosed by the references cited. See Office Action at p. 5. Therefore, Applicant respectfully submits that claim 1 is allowable for at least the same reasons that claims 10, 25 and 26 were indicated to include allowable subject matter.

As for claim 4, which depends from claim 1 and therefore include all of the features recited in claim 1, it is respectfully submitted that Starz et al. do not anticipate claim 4 for at least the reasons submitted above in support of the patentability of claim 1.

Claims 3, 5 and 7 have been amended herein without prejudice to depend from claim 10, which was indicated to include allowable subject matter, and claims 6 and 9 have been amended herein without prejudice to depend from claim 24, which was indicated to include allowable subject matter. It is therefore respectfully submitted that the present rejection is moot with respect to claims 3, 5 to 7 and 9.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**VI. Rejection of Claim 25 Under 35 U.S.C. § 103(a)**

Claim 25 was rejected under 35 U.S.C. § 103(a) as unpatentable over Starz et al. Applicant respectfully submits that Starz et al. do not render unpatentable claim 25 for at least the following reasons.

Claim 25 has been amended herein without prejudice to depend from claim 10, which was indicated to include allowable subject matter. As such, it is respectfully submitted that the present rejection is moot, and withdrawal of this rejection is respectfully requested.

**VII. Allowable Subject Matter**

Applicant notes with appreciation the indication of allowable subject matter contained in claims 10, 24 and 26. The Examiner will note that each of claims 10, 24 and 26 has been rewritten herein in independent form to include all of the features recited its respective base claims and any intervening claims. It is therefore respectfully submitted that claims 10, 24 and 26 are in condition for immediate allowance.

Claims 3, 5, 7 and 25 have been amended herein without prejudice to depend from claim 10. It is therefore respectfully submitted that these claims are also in condition for immediate allowance.

Claims 6 and 9 have been amended herein without prejudice to depend from claim 24. It is therefore respectfully submitted that these claims are also in condition for immediate allowance.

**VIII. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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